

Remarks

The non-final Office Action dated December 12, 2008, lists the following rejections: claims 1, 11 and 21 stand rejected under 35 U.S.C. § 102(b) over Young (U.S. Patent 6,011,950); claims 2-8, 12-18 and 22 stand rejected under 35 U.S.C. § 103(a) over the '950 reference in view of Myers (U.S. Patent No. 6,771,710); claims 9-10, 19-20 and 23-24 stand rejected under 35 U.S.C. § 103(a) over the '950 reference; and claims 21-24 stand rejected under 35 U.S.C. § 101. In this discussion set forth below, Applicant does not acquiesce to any rejection or averment in this Office Action unless Applicant expressly indicates otherwise.

Applicant respectfully traverses the § 102(b) and § 103(a) rejections of claims 1-24 because the Office Action improperly maintained these rejections without responding to the substance of Applicant's previous arguments as required. *See, e.g.,* M.P.E.P. § 707.07(f) ("Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it."). In particular, the Office Action has simply repeated the § 102(b) rejection of claims 1, 11 and 21, which relies upon a flawed assertion of inherency, without responding in any manner to Applicant's previous arguments regarding the impropriety of the Office Action's unsupported conclusion of inherency. The following discussion particularly addresses the impropriety of the Office Action's assertion of inherency.

The Office Action assertions regarding a QAM modulator (*e.g.*, 56 in Fig. 2 of the '950 reference) inherently including an upconverter do not address the claimed invention, which includes aspects directed to upconverting the modulated signal that is produced by a modulator. *See, e.g.,* M.P.E.P. § 2112 ("In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art."). The cited portions of the '950 reference do not teach that the modulated cable signal 57 produced by QAM modulator 56 is upconverted before it is distributed over the cable network. *See, e.g.,* Col. 6:66 to Col. 7:2. In fact, the '950 reference does not make any mention of upconverting the cable signal 57 that is produced by modulator 56. Applicant submits that the system taught by the '950 reference functions without the need to upconvert cable signal 57. As such, it is a mere

possibility that the modulated cable signal 57 could be upconverted. Such possibilities are not sufficient to establish inherency. Accordingly, the § 102(b) rejection of claims 1, 11 and 21, as well as the § 103(a) rejection of dependent claims 2-10, 12-20 and 22-24, are improper and Applicant requests that they be withdrawn.

Notwithstanding, in an effort to facilitate prosecution, Applicant has amended the claims to include aspects directed to the transcoder being part of a system, located at a subscriber's premises, that includes an antenna and a set-top box. Applicant submits that none of the cited references teach or suggest such aspects. *See, e.g.*, Col. 3:60-4:32 of the '950 reference, and Col. 1:48-57 of the '710 reference. As such, Applicant requests that the § 102(b) and § 103(a) rejections of claims 1-24 be withdrawn.

Applicant respectfully traverses the § 101 rejection of claims 21-24 because these claims are directed to statutory subject matter. The Office Action improperly asserts that these claims are directed to non-functional descriptive material. M.P.E.P. § 2106.01 (cited by the Office Action) identifies non-functional descriptive material as being printed matter, and lists the following examples of non-functional descriptive material: "music, literary works, and a compilation or mere arrangement of data." Applicant submits that claims 21-24 do not contain any such limitations. As such, the Office Action fails to establish a basis for the § 101 rejection of claims 21-24. Accordingly, the § 101 rejection of claims 21-24 is improper and Applicant requests that it be withdrawn.

In view of the remarks above, Applicant believes that each of the rejections has been overcome and the application is in condition for allowance. Should there be any remaining issues that could be readily addressed over the telephone, the Examiner is asked to contact the agent overseeing the application file, Peter Zawilski, of NXP Corporation at (408) 474-9063 (or the undersigned).

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